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Atty. Dkt. No 081356/0154

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Kazuo Kobayashi et al.

Title: ENDO- $\beta$ -N-ACETYLGLUCOSAMINIDASE  
GENE

Appl. No.: 09/700,993

Filing Date: 11/22/00

Date:

Examiner: Unassigned

Art Unit: Unassigned

## HAND-DELIVERED TO:

Ms. ~~Carol Kretz~~ Cynthia Kretz  
Attorney Advisor  
PCT Legal Office

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05 FEB 2002

Legal Counsel  
International DivisionTRANSMITTAL OF RENEWED SUBMISSION UNDER 37 CFR 1.42Commissioner for Patents  
Washington, D.C. 20231

Sir:

In response to the Decision on Declaration dated December 5, 2001, in which a response is due to be filed on or before February 5, 2002, transmitted are:

- [ X ] Copy of Decision on Declaration;
- [ X ] Petition Under 37 CFR 1.42 in Support of a Declaration by the legal representative of a deceased co-inventor; and
- [ X ] An executed Declaration by the deceased inventor's legal representative.

Although Applicants believe that know fees are due, the Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned,

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## FACSIMILE TRANSMISSION

Total # of Pages 12 (including this page)

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From: Dexter Forbes for  
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Date: February 5, 2002  
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### MESSAGE:

Courtesy Copy of Response to Decision on Declaration filed February 4, 2002

If there are any problems with this transmission or if you have not received all of the pages, please call (202) 672-5352.

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Atty. Dkt. No 081356/0154

post-dated, otherwise improper or informal or even entirely missing, the  
Commissioner is authorized to charge the unpaid amount to Deposit Account  
No. 19-0741.

Respectfully submitted,

Date

4 February 2002

By

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DEC 05 2001

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In re Application of  
KOBAYASHI et al.  
Application No.: 09/700,993  
PCT No.: PCT/JP99/02644  
Int. Filing Date: 20 May 1999  
Priority Date: 22 May 1998  
For: ENDO-B-N-ACETYLGLUCOSAMINIDASE GENE :

DECISION ON

DECLARATION

This is a decision on the submission filed in the United States Patent and Trademark Office (USPTO) on 20 July 2001 in response to the 22 May 2001 Notification of Missing Requirements.

### BACKGROUND

On 22 May 2001, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath/declaration and a surcharge for filing after the 30 month period was required. The notification set a two-month time period in which to respond.

On 20 July 2001, applicants filed a Declaration and Power of Attorney signed by Yoriko Takeuchi, spouse and legal representative of second inventor, Makoto Takeuchi. There is no indication that Mr. Takeuchi is either deceased, insane or legally incapacitated.

### DISCUSSION

The declaration submitted on 20 July 2001 identifies each inventor and country of citizenship of each inventor and states the relationship of Yoriko Takeuchi as legal representative of inventor Makoto Takeuchi. The declaration also states the citizenship, residency and mailing address of the legal representative. However, applicants have not explained whether the declaration is being filed under 37 CFR 1.42 [When the inventor is dead] or 1.43 [when the inventor is insane or legally incapacitated]. Thus, the requirements of 37 CFR 1.497 have not been met and the declaration is unacceptable at this time.

Accordingly, it is inappropriate to accord the application status under either 37 CFR 1.42 or 1.43 at this time.

### CONCLUSION

For the above reasons, the declaration filed on 02 March 2001 is unacceptable and the request for acceptance of the declaration as a proper response to the Notification of Missing

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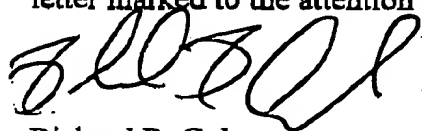
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Requirements is **DISMISSED without prejudice.**

If reconsideration of the merits of the request for status under 37 CFR 1.42 or 1.43 is desired, applicant is required to correct the above-noted defects within TWO (2) MONTHS from the mail date of this Decision. Failure to respond will result in the abandonment of the application. Any reconsideration request should include a cover letter entitled "Renewed Submission" under 37 CFR 1.42 under 37 CFR 1.43.

Extensions of time may be obtained under 37 CFR 1.136(a).

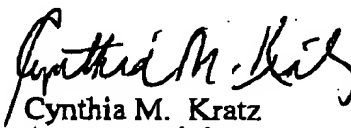
Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



Richard R. Cole  
Legal Examiner  
PCT Legal Office

CMK/RRC:cmk

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